

## REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

In the Official Action mailed July 25, 2007, the Patent Office has asserted that the Amendment previously filed on May 9, 2007, is not fully responsive to the rejections set forth in paragraphs 4, 5, 7 and 9 of the Official Action mailed January 9, 2007. In further response to such Official Action, Applicants submit the foregoing amendments and the following additional remarks.

By the above amendments, claim 1 has been amended to recite a chain extender containing "a carboxylic acid group." Support for such amendment can be found in the instant specification at least at page 4, lines 25-29. Claims 1, 7-9 and 11 have been amended for readability purposes to recite the phrase "a mixture thereof." Support for newly added dependent claim 23 can be found in the instant specification at least at page 5, lines 20-22.

In paragraph 4 of the Official Action mailed January 9, 2007, the Examiner has asserted that polyurethanes having melting temperatures as low as -30°C, are not enabled by Applicants' disclosure. At the outset, it is respectfully noted that this rejection is moot in view of the fact that the melting temperature characteristic objected to by the Examiner is not even explicitly recited in the claims. Moreover, to the extent that the claims would otherwise encompass any inoperative subject matter such as a polyurethane having an inoperably low melting temperature as alleged by the Patent Office, it is noted that any such inoperative embodiments are excluded by the preambles of claims 1 and 21. See M.P.E.P. §2164.08(b). Claim 1 explicitly recites a process for manufacturing a polyurethane, and claim 21 explicitly recites a polyurethane. By positively reciting a polyurethane, such claims exclude any polyurethanes which could not have been made or used due to an inoperably low melting temperature. It is clear that the claims as

currently recited are in full compliance with the enablement requirement of 35 U.S.C. §112, second paragraph. Accordingly, withdrawal of this rejection is respectfully requested.

Applicants note that the rejection set forth in paragraph 5 of the Official Action concerning the chain extender containing a carboxylic acid group is moot in light of the above amendment of claim 1, which now recites a chain extender containing a carboxylic acid group. Accordingly, withdrawal of this rejection is respectfully requested.

Concerning the rejection of claims 21 and 22 set forth in paragraphs 7 and 9, it is noted a response to the rejection based on *Klauck et al* was previously provided at pages 9-10 of the Amendment filed May 9, 2007. As discussed therein, the Patent Office has not established with the requisite certainty that the compound disclosed by *Klauck et al* inherently possesses the claimed tensile modulus characteristic. It is respectfully submitted that the same is true with regard to the compound disclosed by *Ramanathan et al*.

In this regard, the Patent Office's burden of proof for properly alleging an inherent disclosure is well established. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent feature necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In the present case, the materials employed to form the polyurethane described in Applicants' disclosure differ from those employed in *Klauck et al* and *Ramanathan et al* (Official Action at page 4). The Patent Office has not provided sufficient explanation or

scientific reasoning as to why it is certain, given such different reactants, that the resulting compounds of *Klauck et al* and *Ramanathan et al* are identical to the claimed polyurethane. Simply put, the Patent Office has failed to meet its burden of proof for establishing inherency of this claimed feature. For at least this reason, *Ramanathan et al* and *Klauck et al* fail to constitute an anticipation of claims 21 and 22. Accordingly, withdrawal of the above rejections is respectfully requested.

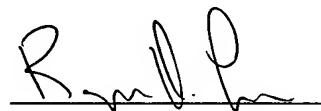
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: October 25, 2007

By: \_\_\_\_\_



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